



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, DC 20231  
www.uspto.gov

APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO	CONFIRMATION NO
09 986,666	11 09 2001	Chien Ho	002547 20118 div3	5772

7590

04 09 2003

Mary-Elizabeth Buckles, Esq.  
REED SMITH LLP  
East Tower - Suite 1100  
1301 K Street, N.W.  
Washington, DC 20005-3317

EXAMINER

CARLSON, KAREN C

ART UNIT

PAPER NUMBER

1653

DATE MAILED: 04.09.2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/986,666

Applicant(s)

HO ET AL.

Examiner

Karen Cochrane Carlson, Ph.D.

Art Unit

1653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on filing.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 20-29, 31, 32, 36 and 37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 20-29, 31, 32, 36, 37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper Note(s)
- 4) ☐ Interview Summary (PTO-413) Paper Note(s)
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other

Art Unit: 1653

Claims 1-19, 30, and 33-35 have been canceled. Claims 20-29, 31, 32, 36, and 37 are currently pending and are under examination.

Priority is to the filing date of the instant application, June 21, 2000.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 20-29, 31, 32, 36, and 37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is noted that SEQ ID NO: 7 is a nucleic acid sequence and therefore cannot describe the hemoglobin beta-chain protein amino acid sequence, or provide basis for amino acid residue at position 105 of the beta chain. Therefore, because all claims recite or depend from a claim reciting SEQ ID NO: 7 the claims are indefinite.

Indeed, no amino acid sequence is provided that depicts the amino acid sequence of human beta chain. Applicants should submit the sequence and comply with the sequence rules again in response to this Office Action, being careful not to add new matter by pointing out where in the specification the sequence is disclosed, in a cited reference, for example.

The closest prior art of record is the substitution of Beta Leu105Phe which is a naturally occurring mutation named HB South Milwaukee (Honig et al., 1990; Am J. Hematology 34(3):

by those skilled in the art to retain structure and function, and therefore one skilled in the art

Art Unit: 1653

would not expect that the substitution of Leu105Trp would lower oxygen affinity. Additional reference is made to MPEP 2144.08(II)(4)(c):

(c) Consider the Teachings of Structural Similarity. Consider any teachings of a "typical," "preferred," or "optimum" species or subgenus within the disclosed genus. If such a species or subgenus is structurally similar to that claimed, its disclosure may motivate one of ordinary skill in the art to choose the claimed species or subgenus from the genus, based on the reasonable expectation that structurally similar species usually have similar properties. See, e.g., *Dillon*, 919 F.2d at 693, 696, 16 USPQ2d at 1901, 1904. See also *Deuel*, 51 F.3d at 1558, 34 USPQ2d at 1214 ("Structural relationships may provide the requisite motivation or suggestion to modify known compounds to obtain new compounds. For example, a prior art compound may suggest its homologs because homologs often have similar properties and therefore chemists of ordinary skill would ordinarily contemplate making them to try to obtain compounds with improved properties."). . . . . **In the area of biotechnology, an exemplified species may differ from a claimed species by a conservative substitution ("the replacement in a protein of one amino acid by another, chemically similar, amino acid . . . [which] is generally expected to lead to either no change or only a small change in the properties of the protein."** *Dictionary of Biochemistry and Molecular Biology* 97 (John Wiley & Sons, 2d ed.1989)). The effect of a conservative substitution on protein function depends on the nature of the substitution and its location in the chain. Although at some locations a conservative substitution may be benign, in some proteins only one amino acid is allowed at a given position. For example, the gain or loss of even one methyl group can destabilize the structure if close packing is required in the interior of domains. *James Darnell et al., Molecular Cell Biology* 51 (2d ed. 1990). The closer the physical and chemical similarities between the claimed species or subgenus and any exemplary species or subgenus disclosed in the prior art, the greater the expectation that the claimed subject matter will function in an equivalent manner to the genus. See, e.g., *Dillon*, 919 F.2d at 696, 16 USPQ2d at 1904 (and cases cited therein). Cf. *Baird*, 16 F.3d at 382-83, 29 USPQ2d at 1552 (disclosure of dissimilar species can provide teaching away).

The MPEP recognizes that conservative amino acid substitutions are obvious and not expected to impact function. The MPEP also recognizes that structural relationships provide the requisite motivation or suggestion to modify known compounds to obtain new compounds. However, Applicants have provided the unexpected result that the conservative amino acid substitution at Leu105Trp of hemoglobin lowers oxygen affinity, and this result was not predictable from the art of record. Therefore, the claimed hemoglobin mutant is novel over the art of record.

Art Unit: 1653

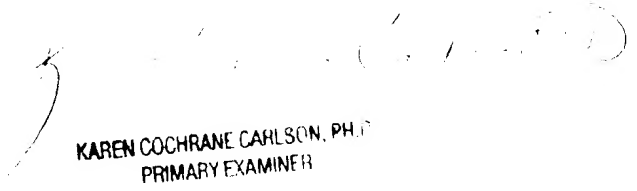
Claims 20-29, 31, 32, 36, and 37 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

Since allowable subject matter has been indicated, applicant is encouraged to submit formal drawings in response to this Office Action. The early submission of formal drawings will permit the Office to review the drawings for acceptability and to resolve any informalities remaining therein before the application is passed to issue. This will avoid possible delays in the issue process.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen Cochrane Carlson, Ph.D. whose telephone number is 703-308-0034. The examiner can normally be reached on 7:00 AM - 4:00 PM, off alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Christopher Low can be reached on 703-308-2329. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

  
KAREN COCHRANE CARLSON, PH.D.  
PRIMARY EXAMINER